

REMARKS

Claims 1-3, 5-6, 8 and 21-36 are pending. Claim 21 is amended herein. No new matter is added as a result of the claim amendments.

103(a) Rejections

The instant Office Action states that Claims 1-3, 5-6, 8 and 21-36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ho (U.S. Patent No. 6,407,757) in view of Kolb et al. ("Kolb;" U.S. Patent No. 6,028,923). The Applicant has reviewed the cited references and respectfully submits that the present invention as recited in Claims 1-3, 5-6, 8 and 21-36 is not anticipated nor rendered obvious by Ho and Kolb, alone or in combination.

Claims 1-3, 5-6 and 8

Independent Claim 1 recites that an embodiment of the present invention is directed to a computer system that includes "a user interface ... operable to change at least a portion of ... content on ... display, said user interface comprising a plurality of flexible layers of material fastened to each other along a single edge in a stack, wherein along other edges of said stack said layers are not fastened to each other and wherein said user interface is incorporated as a part of a housing that houses said computer system." Claims 2-3, 5-6 and 8 are dependent on Claim 1 and recite additional limitations.

Applicant respectfully agrees with the statement in the Office Action that Ho does not teach a user interface incorporated as part of the housing that houses the computer system. Applicant respectfully disagrees that Kolb, in combination with Ho, overcomes this shortcoming.

Kolb only shows a user interface that can be implemented as an internal system that is incorporated into customer premises termination equipment. However, the present claimed invention pertains to a particular type of user interface. Kolb and Ho, even if combined, do not show or suggest the claimed type of user interface incorporated as part of the housing of a computer system.

More importantly, Applicant respectfully submits that there must be some suggestion or motivation to combine Ho and Kolb. Applicant respectfully contends that there is no such suggestion or motivation in either Ho or Kolb. Each of the references is complete and functional in and of itself, so there is no reason to use parts from one, substituted for parts of another. Furthermore, as understood by the Applicant, it would be necessary to make modifications not taught by the references in order to combine the references in the manner suggested; otherwise, the references produce an inoperative combination. For example, there is no teaching in either Kolb or Ho as to how Ho's browsing device accomplishes the push button functionality required by Kolb.

Consequently, Applicant respectfully disagrees with the statements in the instant Office Action that it would have been obvious to one of ordinary skill in the art to combine the teachings of Ho and Kolb.

Therefore, Applicant respectfully submits that the basis for rejecting Claim 1 under 35 U.S.C. § 103(a) is traversed, and that Claim 1 is in condition for allowance. Accordingly, Applicant also respectfully submits that the basis for rejecting Claims

2-3, 5-6 and 8 under 35 U.S.C. § 103(a) is traversed, as these claims are dependent on an allowable base claim and recite additional limitations.

Claims 21-28

Independent Claim 21 recites that an embodiment of the present invention is directed to a computer system that includes “a housing sized to be held in one hand of a user; ... and a user interface ... comprising a plurality of flexible layers of material fastened to each other along an edge in a stack, wherein said edge is mounted on said housing without a cable external to said housing and wherein simultaneously said user interface is operated and said portable computer is held with the same said hand.” Claims 22-28 are dependent on Claim 21 and recite additional limitations.

Applicant respectfully agrees with the statement in the Office Action to the effect that Ho does not teach the limitations of Claim 21. Applicant respectfully disagrees that Kolb, in combination with Ho, overcomes this shortcoming.

Kolb only shows a user interface that can be implemented as an internal system that is incorporated into customer premises termination equipment. However, the present claimed invention pertains to a particular type of user interface. Kolb and Ho, even if combined, do not show or suggest the claimed type of user interface incorporated as part of the housing of a computer system.

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references is complete and functional in and of itself, so there is no reason to use parts from one, substituted for parts of another. Furthermore, as understood by the Applicant, it would be necessary to make modifications not taught by the references in order to combine the references in the manner suggested; otherwise, the references produce an inoperative combination. For example, there is no teaching in either Kolb or Ho as to how Ho's browsing device accomplishes the push button functionality required by Kolb.

Furthermore, Applicant respectfully submits that, at the time of the claimed invention, it was not obvious to combine the teachings of Ho and Kolb. Applicant respectfully submits that the existing level of ordinary skill in the art at the time the claimed invention was made is summarized in the background art section of the instant application. As described therein, the paradigm of applying conventional user interface mechanisms to hand-held, portable devices does not take full advantage of the user's capability to control and manipulate such devices with a single hand. It is reasonable to infer that these problems would not have persisted had the claimed invention been obvious. Instead, those of ordinary skill in the art continued to encounter the disadvantages of the prior art without obvious solution. Applicants respectfully assert that the fact that the claimed type of user interface was not mounted onto a portable computer system by those skilled in the art prior to the invention provides evidence of the nonobviousness of the present claimed invention.

Consequently, Applicant respectfully disagrees with the statements in the instant Office Action that it would have been obvious to one of ordinary skill in the art to combine the teachings of Ho and Kolb.

Therefore, Applicant respectfully submits that the basis for rejecting Claim 21 under 35 U.S.C. § 103(a) is traversed, and that Claim 21 is in condition for allowance. Accordingly, Applicant also respectfully submits that the basis for rejecting Claims 22-28 under 35 U.S.C. § 103(a) is traversed, as these claims are dependent on an allowable base claim and recite additional limitations.

Claims 29-36

Independent Claim 29 recites that an embodiment of the present invention is directed to a computer system that includes “a cursor control element coupled to said processor and operable to change said display, said cursor control element operable to control the coordinates of a cursor displayed on said display device by detecting said cursor control element’s motion relative to a surface on which said cursor control element sits, said cursor control element comprising a plurality of flexible layers of material fastened to each other along an edge in a stack, wherein said edge is mounted on a housing of said cursor control element, and wherein movement of one or more of said flexible layers causes said display to change.” Claims 30-36 are dependent on Claim 29 and recite additional limitations.

Thus, the present claimed invention pertains to a particular type of user interface mounted on a cursor control element. Claim 30 in particular recites a computer mouse and, when read in combination with the limitations of its base claim, Claim 30 more specifically recites a particular type of user interface mounted on a mouse.

Applicant respectfully submits that neither Ho nor Kolb nor the combination thereof shows or suggests the limitations of Claim 29. The instant Office Action states that Ho suggests a mouse. For the sake of argument, if Ho does indeed suggest a mouse, Applicant respectfully submits that Ho, alone or in combination with Kolb, does not show or suggest mounting the particular type of claimed user interface on a cursor control element as recited in Claim 29, or more specifically, on a mouse as recited in Claim 30.

Therefore, Applicant respectfully submits that the basis for rejecting Claim 29 under 35 U.S.C. § 103(a) is traversed, and that Claim 29 is in condition for allowance. By similar rationale, Applicant respectfully submits that the basis for rejecting Claim 30 under 35 U.S.C. § 103(a) is traversed, and that Claim 30 is in condition for allowance. In addition, Applicant respectfully submits that, because Claims 30-36 are dependent on an allowable base claim and recite additional limitations, the basis for rejecting Claims 30-36 under 35 U.S.C. § 103(a) is traversed.

Conclusions

In light of the above remarks, Applicant respectfully requests reconsideration of the rejected claims.

Based on the arguments presented above, Applicant respectfully asserts that Claims 1-3, 5-6, 8 and 21-36 overcome the rejections of record and, therefore, Applicant respectfully solicits allowance of these claims.

The Examiner is invited to contact Applicant's undersigned representative if the Examiner believes such action would expedite resolution of the present Application.

Respectfully submitted,

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